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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,509	01/26/2001	Kazuhisa Hayakawa	080542/0155	6118

22428 7590 11/19/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/769,509

Applicant(s)

HAYAKAWA ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-8, 11-16 and 19 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 10, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on 09/09/2003 has been fully considered. Claims 1-3 and 5-8 are amended, claims 20 and 21 are added, and thus claims 1-21 are pending. (NOTE: Claims 20 and 21 are withdrawn from consideration as non-elected species. **See** the following reason).

#### ***Election/Restrictions***

2. Newly submitted claims 20 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 20 and 21 are classified as a different species because the claims are directed to a printed film sheet or a printed overhead projector transparency medium.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20 and 21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

3. Claims 1, 2, 9, 10, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Breckwoldt (US 5,166,333).

Breckwoldt discloses a transparent methyl hydroxypropyl cellulose ether film (abstract and col. 4, lines 5-13 and lines 33-35). Applicant recites in the rejected claims

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1, 2, 17 and 18 that the claimed film is used for directly printing on the film and that an ink jet printer is used for printing on the film. However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

4. Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch et al. (US 3,899,452).

Koch discloses a self-supporting cellulose ether film, wherein the cellulose ether is preferably hydroxyethyl cellulose ether or hydroxypropyl cellulose ether (abstract and col. 1, line 38). Applicant recites in the rejected claims 1 and 2 that the claimed film is used for directly printing on the film and that an ink jet printer is used for printing on the film. However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

5. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch (US 3,840,395).

Koch discloses a fibrous, non-fibrous or a combination of fibrous and non-fibrous cellulosic sheet made of hydroxyethyl cellulose ether (abstract and col. 1, lines 39 and 54). Applicant recites in the rejected claims 1 and 2 that the claimed film is used for

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directly printing on the film and that an ink jet printer is used for printing on the film.

However, an apparatus used for printing on the film and an intention of printing on the film are not given patentable weight because applicant is neither claiming an apparatus for printing on the film nor claiming a film having a printed matter directly printed on the film.

### ***Response to Arguments***

6. Applicant's argument is based on that none of the prior arts teach or suggest a film adapted for use with overhead projectors comprising a cellulose ether without intervention of a layer adapted to be receptive to a jet printing ink. Furthermore, the term "adapted to" should be given a patentable weight. Currently, the term "adapted to" has been given patentable weight. However, the above argument is not persuasive because all of the prior arts do not expressly exclude directly printing on the film. In addition, since the films in each of the prior art are substantially identical to the claimed film sheet or overhead projector transparency medium the films in each of the prior art function in the same manner as the claimed invention. Where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The ***prima facie*** can be rebutted by evidence showing that the prior art products do not necessarily possess the

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characteristics of the claimed product. For the above reasons claims 1, 2, 9, 10, 17 and 18 stand rejected.

***Allowable Subject Matter***

7. Claims 3-8, 11-16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest arts Breckwoldt (US 5,166,333), Koch et al. (US 3,899,452) and Koch (US 3,840,395) neither teach nor suggest a cellulose ether film, wherein the cellulose ether is characterized in that, in 2 ml of an aqueous solution obtained by mixing 0.1 part by weight of the cellulose ether with 99.9 parts by weight of water at 20°C, the number of undissolved fibers having a length of 8 to 200 µm is not greater than 1,000, and wherein said cellulose ether is characterized in that, when 100 g of the cellulose ether is shaken on a sieve having an opening of 150 µm, the amount of cellulose ether remaining on the sieve is not greater than 25% by weight.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

BS B.S.  
November 16, 2003.

CYNTHIA H. KELLY  
SUPERVISOR, ELECTRONIC ENGINEERING  
TECHNOLOGY CENTER

*Cynthia H Kelly*